REMARKS

Applicants have carefully reviewed this Application in light of the Office Action mailed June 12, 2006. Claims 8, 9, 13, 20 and 23 have been cancelled without prejudice or disclaimer and Claims 1-7, 10-12, 14-19, 21, 22, and 24-29 are pending in this Application. Claims 15-21 stand rejected under 35 U.S.C. § 101, Claim 25 stands rejected under 35 U.S.C. § 112, second paragraph, Claims 1, 2, 6, 8-13, 15 and 16 stand rejected under 35 U.S.C. § 102(e), and Claims 3-5, 7, 14 and 17-29 stand rejected under 35 U.S.C. § 103(a). Claims 1, 10, 15, 22, 24, 25 and 29 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Claim Objections

Claim 29 was objected to by the Examiner because of informalities. Applicants have amended Claim 29 to overcome this objection and respectfully request reconsideration, withdrawal of the rejection and full allowance of Claim 29 as amended.

Rejections under 35 U.S.C. § 101

Claims 15-21 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner alleges that Claim 15, line 6 recites "a program of instructions" and that a program of instructions in and of itself may not be patented. (Office Action, Page 2). Furthermore, the Examiner has suggested the Applicants include language such as a "program of instructions embodied in computer readable media" similar to that of Claim 1. Although Applicants traverse this rejection, in order to reduce the cost and time associated with obtaining patent protection, Applicants have amended Claim 15 to recite that the program of instructions is embodied on computer readable media. Accordingly, Applicants respectfully request reconsideration, withdrawal of the rejection under 35 U.S.C. § 101 and full allowance of Claims 15-21 as amended.

Rejections under 35 U.S.C. § 112

Claim 25 stands rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter

which Applicants regard as the invention. Specifically, the Examiner alleges that the recitation of the limitation "the memory module associated with the isolated memory system device" lacks antecedent basis. Applicants have amended Claim 25 to overcome these rejections and respectfully request reconsideration, withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, and full allowance of Claim 25 as amended.

Rejections under 35 U.S.C. § 102

Claims 1, 2, 6 and 8-13 stand rejected by the Examiner under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,766,474 issued to Todd A. Schelling ("*Schelling*").

Claims 15 and 16 stand rejected by the Examiner under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,792,561 issued to Tohru Mamata ("*Mamata*").

Claims 1 and 10

Schelling teaches a system with the ability to dynamically add resources to and remove sources from the system during runtime operation. (Col. 3, lines 28-30).

Claim 1, as amended, recites software for diagnosing a memory system operable to "facilitate isolation of the at least one selected memory system device by disabling all system memory devices except the at least one selected memory device or disabling the at least one selected memory device."

Claim 10, as amended, recites software for managing a memory system, the software operable to "disable the selected memory system device."

Applicant respectfully submits that *Schelling* cannot anticipate the rejected Claims, because it fails to show all elements of the present Claims. For instance, *Schelling* fails to teach software for diagnosing a memory system operable to "facilitate isolation of the at least one selected memory system device by disabling all system memory devices except the at least one selected memory device or disabling the at least one selected memory device," as recited by amended Claim 1. In rejecting Claims 8 and 9, the limitations of which have been incorporated into amended Claim 1, the Examiner alleges that "disabling all system memory devices except the at least one selected memory system device" is disclosed at Col. 4, lines 3-

6 of *Schelling*, and "disabling the at least one selected memory system device" is disclosed at Col. 4, lines 3-22 of *Schelling*. (Office Action, Pages 4-5). This portion of *Schelling* states:

> [I]n one embodiment, the BIOS program **14** retains a portion of the memory **20** (retained memory **20a**) while relinquishing control of the remainder of the memory **20** (relinquished memory **20b**) to the operating system **16**. In one embodiment, the relinquished memory **20b** includes enough of the total memory **20** to enable the system **100** to be fully functional. As will be shown, below, the BIOS program **14** initializes and tests the retained memory **20a**. Following the memory test, the retained memory **20a** may be released to the operating system **16** or, in other words, become relinquished memory **20b**.
>
> In one embodiment, the BIOS program **14** releases the memory **20** in stages, e.g., tests a first portion of retained memory **20a**, releases the first portion, tests a second portion of retained memory **20a**, releases the second portion, tests a third portion of retained memory **20a**, releases the third portion and so on. In a second embodiment, the BIOS program **14** tests all the retained memory **20a** first, then releases the retained memory **20a** to the operating system **16**.

(Col. 4, lines 3-22). Referring to the passage cited above, the Examiner interprets the relinquishment of memory disclosed in *Schelling* as equivalent to "disabling all system memory devices except the at least one selected memory device" and interprets the retention of a portion of memory disclosed in *Schelling* as equivalent to "disabling the at least one selected memory system." (Office Action, Pages 4-5). The Examiner's allegations of equivalence fail for a number of reasons.

First, the Applicants note that the Examiner has interpreted both the relinquishment and retention of memory devices as equivalent to "disabling" such a memory device, even though the portion of *Schelling* cited by the Examiner contemplates that the relinquishment and retention operations disclosed therein are mutually exclusive operations. Accordingly, logic dictates that the relinquishment and retention operations disclosed by *Schelling* cannot both be equivalent to "disabling" a memory device.

Second, the Examiner incorrectly states that "relinquishment is interpreted as disabling memory portion 20b from being tested." (Office Action, Page 4). Assuming that an operation which prevents a memory device from being tested is analogous to disabling of the device, which Applicants do not concede, the Examiner fails to cite to any portion of *Schelling* that discloses that the relinquishment operation prevents or disables a memory

device from being tested. Thus, *Schelling* fails to disclose "disabling all system memory devices except the at least one selected memory device."

Third, the Examiner incorrectly states that "retaining a portion of memory is interpreted as disabling of that portion of memory from being used by the operating system." (Office Action, Page 5). This argument fails as *Schelling*'s disclosure of retaining memory does not disclose the affirmative operation of disabling memory, as the memory is at no point enabled prior to retention disclosed by *Schelling*. Thus, logic dictates that because the memory is not enabled, it cannot be disabled by *Schelling*'s retention operation.

Schelling fails to disclose the recited limitations, and therefore, cannot anticipate Claim 1. For the same or analogous reasons to those discussed above, *Schelling* also fails to teach "software for managing a memory system, the software operable to "disable the selected memory system device," as recited in amended Claim 10.

Given that Claims 2, 6, 8 and 9 depend from Claim 1, and Claims 11-13 depend from Claim 10, Applicants respectfully submit that Claims 2, 6, 8, 9 and 11-13 are allowable. As such Applicants respectfully request reconsideration, withdrawal of the rejections under 35 U.S.C. § 102(e), and full allowance of Claims 1, 2, 6 and 8-13.

Claim 15

Mamata teaches an apparatus and method for controlling access to expansion memory. (Col. 2, lines 28-30).

Claim 15, as amended, recites an information handling system including a program of instructions operable to "selectively toggle the operating state for each of the plurality of memory slots between enabled and disabled."

Applicant respectfully submits that *Mamata* cannot anticipate the rejected Claims, because it fails to show all elements of the present Claims. For instance, *Mamata* fails to teach an information handling system including a program of instructions operable to "selectively toggle the operating state for each of the plurality of memory slots between enabled and disabled" as recited by amended Claim 15. *Mamata* fails to disclose the recited limitations, and therefore, cannot anticipate Claim 15.

Given that Claim 16 depends from Claim 15, Applicants respectfully submit that Claim 16 is allowable. As such Applicants respectfully request reconsideration, withdrawal of the rejections under 35 U.S.C. § 102(e), and full allowance of Claims 15 and 16.

Rejections under 35 U.S.C. § 103

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schelling* in view of U.S. Patent No. 7,00,159 issued to Jonathan T. Stern et al. (*"Stern"*).

Claims 4 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schelling* in view of U.S. Patent Application Publication No. 2004/0199830 by Douglas Ray Gilbert et al. (*"Gilbert"*).

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schelling* in view of U.S. Patent No. 6,421,798 issued to Lixin Lin et al. (*"Lin"*).

Claims 7, 14, 15 and 17-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schelling* in view of Official Notice.

Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schelling* in view of Official Notice, further in view of *Lin*.

Claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schelling* in view of Official Notice, further in view of *Lin*, further in view of *Stern*.

Claims 3-5, 7 and 14

Although Applicants makes no concessions regarding the rejections of Claims 3-5, 7 and 14, Applicants believe that: (i) Claims 3-5 and 7 are allowable at least because they depend from and provide further patentable limitations to Claim 1 shown to be allowable above, and (ii) Claim 14 is allowable at least because it depends from and provides further patentable limitations to Claim 10 shown to be allowable above. Accordingly, Applicant requests reconsideration, withdrawal of the rejections under 35 U.S.C. § 103(a), and full allowance of Claims 3-5, 7 and 14.

Claims 15 and 17-29

Claim 15, as amended, recites an information handling system including a program of instructions operable to "selectively toggle the operating state for each of the plurality of memory slots between enabled and disabled."

Claim 22, as amended, recites a method for identifying faulty devices in a memory system including "selecting a memory system device for isolation" and "disabling any remaining memory system devices via the BIOS utility setting."

Applicant respectfully submits that *Schelling* cannot render obvious the rejected Claims, because it fails to show all elements of the present Claims. For the same or analogous reasons to those set forth above with respect to the rejection of Claims 1 and 10 under 35 U.S.C. § 102(e), *Schelling* fails to teach an information handling system including a program of instructions operable to "selectively toggle the operating state for each of the plurality of memory slots between enabled and disabled," as recited by amended Claim 15 and also fails to teach a method for identifying faulty devices in a memory system including "selecting a memory system device for isolation" and "disabling any remaining memory system devices via the BIOS utility setting," as recited by amended Claim 22. *Schelling* fails to disclose, teach or suggest the recited limitations, and therefore, cannot render obvious Claims 15 and 22.

Given that Claims 17-19 and 21 depend from Claim 15, and Claims 24-29 depend from Claim 22, Applicants respectfully submit that Claims 17-19, 21 and 24-29 are allowable. As such Applicants respectfully request reconsideration, withdrawal of the rejections under 35 U.S.C. § 103(a), and full allowance of Claims 15, 17-19, 21, 22, and 24-29.

CONCLUSION

Applicants appreciate the Examiner's careful review of the application. Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. For the foregoing reasons, Applicants respectfully request reconsideration of the rejections and full allowance of Claims 1-7, 10-12, 14-19, 21, 22, and 24-29, as amended.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 02-0383 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2581.

Respectfully submitted,
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Date: September 12, 2006

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